REMARKS/ARGUMENTS

Obviousness - Section 103(a) Rejection

The Examiner has now agreed with the Applicant that the prior rejections under Section 102 based on Allen '224 were improper, but now submits that the claims are all obvious under section 103(a) based on Allen in view of certain other references, such as Glover '724 for instance. The Applicant requests that the Examiner reconsider this obviousness rejection based on the points made below, and based on the argument accompanying the points.

Firstly the Examiner bases the obviousness rejection of all claims on an incorrect premise, namely that the Allen '224 reference discloses all the independent claim elements except the first and the second adapter mount areas. In this case however, **the references combined by the Examiner still do not include all the claim limitations of this application**.

The claims require that the fiber optic adapter holding structures mounted to the tray framework include "a fiber optic cable passageway between the first adapter mount area and the second adapter mount area", and neither Allen '224 nor any of the other references disclose this. At best the Allen reference discloses a plurality of independently mounted adapter holders on a tray, where fiber optic cables happened to be routed between them. The Allen reference **does not disclose,** and does not suggest or teach, that there is a fiber optic holding structure which includes a first adapter mount area and a second adapter mount area, with a fiber optic cable passageway between the two mount

areas. Therefore the Examiner has not met the initial burden of a prima facie case of obviousness because there are still elements missing from the combination of references. A quick glance at the difference in the respective densities which are achievable illustrates this point (although aspects of this invention are not limited by a specific density).

The Applicant submits that this deficiency exists at least with respect to independent claims 1, 19 and 23, and consequently all the claims which depend upon claims 1 and 19, which includes claims 2-18 and claims 20-22.

While the Examiner has rejected claim 24, Applicant is unclear what reference is being utilized to assert that a reference includes the element of "wherein one of the first adapter mount area and the second adapter mount area on the holder framework has a width which is less than or equal to the FC-type adapter width". In the absence of such an assertion, the Applicant submits that there is no prima facie basis for an obviousness rejection against claim 24 and all claims that depend from claim 24, namely including claims 25 and 26.

With respect to claim 28, it requires the fiber optic cable passageway between the first adapter mount area and the second adapter mount area, and for the reasons set forth above with respect to claims 1 and 19, there is no support for this rejection in the record.

With respect to claim 27, item 284 in the Hultermans reference is identified as a latch at column 7, line 5, and not an alignment guide. Applicant asks the Examiner to point out where the alignment features of that are identified.

Even if there is an alignment feature in Hultermans, it does not appear to be arranged to "position the adapter", and there is nothing in either Allen or in Hultermans, which suggests making the combination.

Since there is nothing in the stated references which suggests the desirability of the combination and therefore the Examiner has not met the minimum required showing for *prima facie* obviousness.

In the U.S. Court of Appeals for the Federal Circuit case of *In Re: Lee, 61 U.S.P.Q. 2d 1430,* decided January 18, 2002, the Federal Circuit held:

> ... Thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The Board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The examining attorney has therefore failed to meet the requirement to set forth with specificity the general knowledge in the art to enable a finding that the person having ordinary skill in the art would make such combination.

As the PTO recognizes in MPEP 2142:

> The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has

> the burden of going forward with production of evidence in each step of the examination process.... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-obviousness.... The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

MPEP 2143.01 provides:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re: Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine whether it has been properly made. Thus, *In re: Geiger* stated in holding that the PTO "failed to establish a *prima facie* case of obviousness:

> Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ADC*

Hospital Systems, Inc. V. Monteffore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Conclusion

Applicant therefore submits Claims 1-28 are in a position to proceed to allowance.

Respectfully submitted,

Dated: 11-10-03 By: _____

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